

Application No. 10/789,455
Amendment dated January 18, 2005
Reply to Office Action of October 18, 2004

PATENT

REMARKS/ARGUMENTS

Claims 1-27 were pending in this application. No claims have been amended, added, or cancelled. Hence, claims 1-27 remain pending. Reconsideration of the subject application is respectfully requested.

Claims 1, 3-7, 10, 12-14, 17, 18, 21, 22, 24 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the cited portions of U.S. Patent No. 5,576,951 to Lockwood *et al.* (hereinafter "Lockwood").

Claims 2, 8, 9, 11, 15, 16, 19, 20, 23, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lockwood, in view of the cited portions of U.S. Patent No. 6,802,538 to Laurash *et al.* (hereinafter "Laurash").

Claim Rejections Under 35 U.S.C. § 102(b)

The Applicants respectfully traverse the rejection of all claims since no cited reference teaches the claim limitations, either explicitly or impliedly. For example, no cited reference teaches anything about ordering presentation instruments.

All claims relate to ordering or purchasing a plurality of presentation instruments in a single order (*See, e.g.*, claims 1, 10, 13 and 21). Presentation instruments are not "sales presentations" as taught by Lockwood. Presentation instruments (*e.g.*, credit cards, debit cards, gift cards, and the like) are instruments used to settle purchase transactions (*See, Background, ¶ [0004]*). Hence, not only does Lockwood not teach the claim limitations, Lockwood is not even related to the subject matter of the present application. For this reason alone, claims 1, 10, 13, 21, and those claims that depend from these (*i.e.*, all pending claims) are allowable. Moreover, the claims are allowable for the reasons cited below.

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Though a "sales presentation," as taught by Lockwood, is not a "presentation instrument," the following points assume such to be the case for the sake of argument. The office action cites "case file 111" as teaching "one or more files that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments." At column 13, lines 5-6, Lockwood says, "[o]nce a loan has been approved and accepted it is processed and monitored through an active case file 111." This fails to anticipate the claim limitation for a number of reasons. For instance, Lockwood does not teach that the case file 111 is necessarily "executable by a computer," which the claims require. Further, even if Lockwood taught that the case file is executable by a computer, the case file certainly does not "produce one or more corresponding display screens programmed to collect purchase information." Hence, the office action does not cite a reference that teaches this claim limitation, and all pending claims, which include similar versions of this limitation, are believed to be allowable for this additional reason.

Moreover, the office action also does not cite a reference for a "recipient information file" which is comprised by "purchase information." Nowhere in the cited passages of Lockwood is there taught a recipient information file, and claims 1-9 are believed to be allowable for this additional reason.

For at least the foregoing reasons, all pending claims are believed to be allowable.

Claim Rejections Under 35 U.S.C. § 103(a)

In rejecting claims 2, 8, 9, 11, 15, 16, 19, 20, 23, 26 and 27, the office action cites Laurash for teachings relating to gift cards. This fails to establish a case of *prima facie* obviousness for a number of reasons. First, the gift cards taught by Laurash have no relationship to the "gift cards" claimed by the Applicants. The gift cards of Laurash cannot be used to settle purchase transactions, as discussed above. The gift cards taught by Laurash appear to be merely note cards included with gifts ordered on-line to identify the sender of the gift. Hence, Laurash is non-analogous art *vis-à-vis* the Applicants' claimed invention.

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Further still, gift cards, according to the Applicants' claims, are a subset of "presentation instruments" (*see, e.g.*, claim 2, "wherein the presentation instruments comprise . . . gift cards"). As such, gift cards may be directly substituted for the broader term without losing the meaning of the claim. The gift cards taught by Laurash cannot be substituted for the sales presentation taught by Lockwood and relied on by the office action as an anticipatory teaching of a presentation instrument. Therefore, there is no motivation to combine the teachings.

For at least these additional reasons, claims 2, 8, 9, 11, 15, 16, 19, 20, 23, 26 and 27 are believed to be allowable.

Conclusion

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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